



UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE
United States Patent and Trademark Office
Address: COMMISSIONER FOR PATENTS
P.O. Box 1450
Alexandria, Virginia 22313-1450
www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
-----------------	-------------	----------------------	---------------------	------------------

10/723,228

11/26/2003

Hiroko Ohishi

17275

9157

23389 7590 11/13/2008
SCULLY SCOTT MURPHY & PRESSER, PC
400 GARDEN CITY PLAZA
SUITE 300
GARDEN CITY, NY 11530

EXAMINER

RAJ, RAJIV J

ART UNIT

PAPER NUMBER

3686

MAIL DATE

DELIVERY MODE

11/13/2008

PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary	Application No. 10/723,228	Applicant(s) OHISHI, HIROKO	
	Examiner RAJIV J. RAJ	Art Unit 3686	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 06 October 2008.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1,2,4,5,8-10,12,13 and 18-22 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1,2,4,5,8-10,12,13 and 18-22 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____ |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date <u>06 October 2008</u> . | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Continued Examination Under 37 CFR 1.114

1. A request for continued examination under 37 CFR 1.114, including the fee set forth in 37 CFR 1.17(e), was filed in this application after final rejection. Since this application is eligible for continued examination under 37 CFR 1.114, and the fee set forth in 37 CFR 1.17(e) has been timely paid, the finality of the previous Office action has been withdrawn pursuant to 37 CFR 1.114. Applicant's submission filed on 06 October 2008 has been entered.
2. This action is in reply to the amendment filed on 06 October 2008.
3. Claims 1, 9, 12, and 18 have been amended.
4. Claims 1, 2, 4, 5, 8-10, 12, 13, and 18-22 are currently pending and have been examined.

Claim Rejections - 35 USC § 101

5. 35 U.S.C. 101 reads as follows:

Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

6. Claims 9,10, & 20 are rejected under 35 U.S.C. 101 because the claimed invention is directed to non-statutory subject matter. Based on Supreme Court precedent, a method/process claim must (1) be tied to another statutory class of invention (such as a particular apparatus) (see at least *Diamond v. Diehr*, 450 U.S. 175, 184 (1981);

Parker v. Flook, 437 U.S. 584, 588 n.9 (1978); *Gottschalk v. Benson*, 409 U.S. 63, 70 (1972); *Cochrane v. Deener*, 94 U.S. 780, 787-88 (1876)) or (2) transform underlying subject matter (such as an article or materials) to a different state or thing (see at least *Gottschalk v. Benson*, 409 U.S. 63, 71 (1972)). A method/process claim that fails to meet one of the above requirements is not in compliance with the statutory requirements of 35 U.S.C. 101 for patent eligible subject matter. Here claims 9, 10, & 20 fail to meet the above requirements because the limitations are not tied to a statutory class of invention. Nominal recitations of structure in an otherwise ineligible method fail to make the method a statutory process. See *Benson*, 409 U.S. at 71-72. As *Comiskey* recognized, "the mere use of the machine to collect data necessary for application of the mental process may not make the claim patentable subject matter." *Comiskey*, 499 F.3d at 1380 (citing *In re Grams*, 888 F.2d 835, 839-40 (Fed. Cir. 1989)). Incidental physical limitations, such as data gathering, field of use limitations, and post-solution activity are not enough to convert an abstract idea into a statutory process. In other words, nominal or token recitations of structure in a method claim do not convert an otherwise ineligible claim into an eligible one.

Claim Rejections - 35 USC § 103

7. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

8. The factual inquiries set forth in *Graham v. John Deere Co.*, 383 U.S. 1, 148 USPQ 459 (1966), that are applied for establishing a background for determining obviousness under 35 U.S.C. 103(a) are summarized as follows:

1. Determining the scope and contents of the prior art.
2. Ascertaining the differences between the prior art and the claims at issue.
3. Resolving the level of ordinary skill in the pertinent art.
4. Considering objective evidence present in the application indicating obviousness or nonobviousness.

9. Claims 1, 2, 4, 5, 8-10, 12, 13, and 18 are rejected under 35 U.S.C. 103(a) as being unpatentable over Jeacock et al. (US 6014630) (hereinafter Jeacock) in view of Goldstein (US 200100021910) (hereinafter Goldstein) in further view of Edelson et al. (US 5737539) (hereinafter Edelson).

10. **Examiner's Note:** The Examiner has pointed out particular references contained in the prior art of record within the body of this action for the convenience of the Applicant. Although the specified citations are representative of the teachings in the art and are applied to the specific limitations within the individual claim, other passages and figures may apply. Applicant, in preparing the response, should

consider fully the entire reference as potentially teaching all or part of the claimed invention, as well as the context of the passage as taught by the prior art or disclosed by the Examiner.

As per claim 1, Jeacock teaches:

- *a preprocedure information inputting unit for inputting preprocedure information comprising at least one of a type of a drug used for a preprocedure performed for a patient when performing an endoscopic examination, an amount of the drug, an appliance used for the preprocedure, and a name of a person who performs the preprocedure* (see at least Jeacock Column:2 Lines:49-67 Column:3 Lines:1-10 Column:4 Lines:52-67 & Column:5 Lines:1-12)
- *which is reservation information of the endoscopic examination;* (see at least Jeacock Fig:5 & related text)
- *a first abnormality information indicating presence/absence of an abnormality of a patient;* (see at least Jeacock Column:3 Lines:26-28 “(d) Questions on particular problems, such as allergies, and whether existing medications should be discontinued.”)
- *a second abnormality information indicating the presence/absence of an abnormality of a patient;* (see at least Jeacock Column:3 Lines:26-28)
- *after the preprocedure;* (see at least Jeacock Claim:3)

Jeacock does not disclose the following limitations, however Goldstein, as shown does:

- *a condition inputting unit for displaying the preprocedure information and inputting patient condition information, including information indicating a condition of the patient after the preprocedure;* (see at least Goldstein [0057] “As information is obtained from patient prospects and patients, and from the medical practitioner's office, it may be entered into and retrieved from the system through various forms of input/output devices operatively connected to the main processing unit 10 and each of the remote CPUs 16, such as typing on keyboards, speech to text transcription methods, use of digitizers and scanners and other known methods. Information is displayed in various formats and can be viewed on the display devices 12 and 17 or printed using printers 13 and 18.”)
- *a storing unit correlating and storing the preprocedure information, the patient condition information, and a time of the preprocedure.* (see at least Goldstein [0054] “in a preferred embodiment includes, at the system representation end, a main processing unit 10 with data storage capability.”)

It would have been obvious to one of ordinary skill in the art at the time of the invention to add the features of Goldstein into Jeacock. One of ordinary skill in the art would have added these features into Jeacock with the motivation to provide an improved method and system for recording, transmitting and maintaining patient

information relevant to medical procedures to be performed on a patient, for higher quality health care. (see at least Goldstein [0024])

Jeacock/Goldstein does not disclose the following limitations, however Edelson, as shown does:

- *an examination reservation displaying unit displaying a list of examination reservation information; and (see at least Edelson Fig:2-5, & related text)*
- *a display controlling unit controlling a display form of the examination reservation information displayed on the examination reservation displaying unit, based on the patient condition information. wherein (see at least Edelson Fig:2-5, & related text)*
- *the display controlling unit displays one or more of the examination reservation information from among the examination reservation information displayed in the list, said one or more examination reservation information corresponding to the patient condition information having the first or the second abnormality information indicating the abnormality is occurring in the condition of the patient. (see at least Edelson Fig:2-5, 10, 13 & related text)*

It would have been obvious to one of ordinary skill in the art at the time of the invention to add the features of Edelson to Jeacock/Goldstein. One of ordinary skill in the art would have added these features into Jeacock/Goldstein with the motivation providing effective and cost-efficient way to access, view, modify, and

update patient information, to improve the quality of patient healthcare. (see at least Edelson Column:1 Lines:31-38)

As per claim 2, Jeacock/Goldstein/Edelson as shown, disclose the limitations of claims 1. Goldstein further discloses the following limitation:

- *a correlated information presenting unit presenting a correlation among the preprocedure information, the patient condition information, and the time of the preprocedure, which are stored in the storing unit.* (see at least Goldstein [0046] “means for scheduling and coordinating pre and post-operative medical appointments and procedures between patients and medical practitioners; means for receiving, processing and delivering pre and post procedure care orders and medicament prescriptions from medical practitioners to patients;”)

It would have been obvious to one of ordinary skill in the art at the time of the invention to add the features of Goldstein into Jeacock/Goldstein/Edelson. One of ordinary skill in the art would have added these features into Jeacock/Goldstein/Edelson with the motivation to provide an improved method and system for recording, transmitting and maintaining patient information relevant to medical procedures to be performed on a patient, for higher quality health care. (see at least Goldstein [0024])

As per claim 4, Jeacock/Goldstein/Edelson as shown, disclose the limitations of claims 1. Edelson further discloses the following limitation:

- *the preprocedure information inputting unit is a portable terminal.* (see at least Edelson Column:7 Lines: 43-48) “The prescription management system shown in this embodiment of the invention has been designed for implementation on physically compact, portable, user-interface devices such as small portable personal computers, especially hand held devices known as personal digital assistants.”)

It would have been obvious to one of ordinary skill in the art at the time of the invention to add the features of Edelson to Jeacock/Goldstein/Edelson. One of ordinary skill in the art would have added these features into Jeacock/Goldstein/Edelson with the motivation providing effective and cost-efficient way to access, view, modify, and update patient information, to improve the quality of patient healthcare. (see at least Edelson Column:1 Lines:31-38)

As per claim 5, Jeacock/Goldstein/Edelson as shown, disclose the limitations of claims 1. Edelson further discloses the following limitation:

- *preprocedure information inputting unit is a portable reading device.* (see at least Edelson Column:7 Lines: 43-48 and 3 Read in view of the applicants specification, (Ohishi [0030]) which states that “a PDA (Personal Digital Assistant) may be available as the portable reading device.”)

It would have been obvious to one of ordinary skill in the art at the time of the invention to add the features of Edelson to Jeacock/Goldstein/Edelson. One of ordinary skill in the art would have added these features into

Jeacock/Goldstein/Edelson with the motivation providing effective and cost-efficient way to access, view, modify, and update patient information, to improve the quality of patient healthcare. (see at least Edelson Column:1 Lines:31-38)

As per claim 8, Jeacock/Goldstein/Edelson as shown, disclose the limitations of claims 1. Goldstein further discloses the following limitations:

- *a history information displaying unit displaying a history of the patient condition* (see at least Goldstein [0061])
- *information stored in the storing unit* (see at least Goldstein [0071] “The system contains hardware and software components to capture 26 and store 30”)

It would have been obvious to one of ordinary skill in the art at the time of the invention to add the features of Goldstein into Jeacock/Goldstein/Edelson. One of ordinary skill in the art would have added these features into Jeacock/Goldstein/Edelson with the motivation to provide an improved method and system for recording, transmitting and maintaining patient information relevant to medical procedures to be performed on a patient, for higher quality health care. (see at least Goldstein [0024])

As per claim 9, Jeacock teaches:

- *inputting preprocedure information comprising at least one of a type of a drug used for a preprocedure performed for a patient when performing an endoscopic examination, an amount of the drug, an appliance used for the*

preprocedure, and a name of a person who performs the preprocedure; (see at least Jeacock Column:2 Lines:49-67 Column:3 Lines:1-10, 20-25, 31-34 Column:4 Lines:52-67 & Column:5 Lines:1-12)

- *a first abnormality information indicating presence/absence of an abnormality of a patient; (see at least Jeacock Column:3 Lines:26-28 “(d) Questions on particular problems, such as allergies, and whether existing medications should be discontinued.”)*
- *a second abnormality information indicating the presence/absence of an abnormality of a patient; (see at least Jeacock Column:3 Lines:26-28)*
- *after the preprocedure; (see at least Jeacock Claim:3)*
- *which is reservation information of the endoscopic examination; (see at least Jeacock Fig:5 & related text)*

Jeacock does not disclose the following limitations, however Goldstein, as shown does:

- *inputting patient condition information, including information indicating a condition of the patient after the preprocedure; (see at least Goldstein [0057])*
- *correlating and storing the preprocedure information, the patient condition information, and a time of the preprocedure. (see at least Goldstein [0054])*

It would have been obvious to one of ordinary skill in the art at the time of the invention to add the features of Goldstein into Jeacock/Goldstein/Edelson. One of ordinary skill in the art would have added these features into

Jeacock/Goldstein/Edelson with the motivation to provide an improved method and system for recording, transmitting and maintaining patient information relevant to medical procedures to be performed on a patient, for higher quality health care. (see at least Goldstein [0024])

Jeacock/Goldstein does not disclose the following limitations, however Edelson, as shown does:

- *displaying a list of examination reservation information, which is reservation information of the examination (see at least Edelson Fig:2-5, & related text)*
- *controlling a display form of the displayed examination reservation information, based on the patient condition information (see at least Edelson Fig:2-5, & related text)*
- *the displayed examination reservation information is from among the examination reservation information displayed in the list, said displayed examination reservation information corresponding to the patient condition information having the first or the second abnormality information indicating the abnormality is occurring in the condition of the patient (see at least Edelson Fig:2-5, 10, 13 & related text)*

It would have been obvious to one of ordinary skill in the art at the time of the invention to add the features of Edelson to Jeacock/Goldstein. One of ordinary skill in the art would have added these features into Jeacock/Goldstein with the motivation providing effective and cost-efficient way to access, view, modify, and

update patient information, to improve the quality of patient healthcare. (see at least Edelson Column:1 Lines:31-38)

As per claim 10, Jeacock/Goldstein /Edelson as shown, disclose the limitations of claims 9. Goldstein further discloses the following limitations:

- *presenting a correlation among the preprocedure information, the patient condition information, and the time of the preprocedure, which are stored.* (see at least Goldstein [0046])

It would have been obvious to one of ordinary skill in the art at the time of the invention to add the features of Goldstein into Jeacock/Goldstein/Edelson. One of ordinary skill in the art would have added these features into Jeacock/Goldstein/Edelson with the motivation to provide an improved method and system for recording, transmitting and maintaining patient information relevant to medical procedures to be performed on a patient, for higher quality health care. (see at least Goldstein [0024])

As per claim 12, Jeacock teaches:

- *inputting preprocedure information comprising of at least one of a type of a drug used for a preprocedure performed for a patient when performing an examination, an amount of the drug, an appliance used for the preprocedure, a name of a person who performs the preprocedure;* (see at least Jeacock Column:2 Lines:49-67 Column:3 Lines:1-10, 20-25, 31-34 Column:4 Lines:52-67 & Column:5 Lines:1-12)

- *a first abnormality information indicating presence/absence of an abnormality of a patient; (see at least Jeacock Column:3 Lines26-28 “(d) Questions on particular problems, such as allergies, and whether existing medications should be discontinued.”)*
- *a second abnormality information indicating the presence/absence of an abnormality of a patient; (see at least Jeacock Column:3 Lines26-28)*
- *after the preprocedure; (see at least Jeacock Claim:3)*
- *which is reservation information of the endoscopic examination; (see at least Jeacock Fig:5 & related text)*

Jeacock does not disclose the following limitations, however Goldstein, as shown does:

- *inputting patient condition information, including information indicating a condition of the patient after the preprocedure; (see at least Goldstein [0057])*
- *correlating and storing the preprocedure information, the patient condition information, and a time of the preprocedure. (see at least Goldstein [0054])*

It would have been obvious to one of ordinary skill in the art at the time of the invention to add the features of Goldstein into Jeacock/Goldstein. One of ordinary skill in the art would have added these features into Jeacock/Goldstein with the motivation to provide an improved method and system for recording, transmitting and maintaining patient information relevant to medical procedures to be performed on a patient, for higher quality health care. (see at least Goldstein [0024])

Jeacock/Goldstein does not disclose the following limitations, however Edelson, as shown does:

- *displaying a list of examination reservation information; (see at least Edelson Fig:2-5, & related text)*
- *controlling a display form of the displayed examination reservation information, based on the patient condition information (see at least Edelson Fig:2-5, & related text)*
- *the displayed examination reservation information is from among the examination reservation information displayed in the list, said displayed examination reservation information corresponding to the patient condition information having the first or the second abnormality information indicating the abnormality is occurring in the condition of the patient (see at least Edelson Fig:2-5, 10, 13 & related text)*

It would have been obvious to one of ordinary skill in the art at the time of the invention to add the features of Edelson to Jeacock/Goldstein. One of ordinary skill in the art would have added these features into Jeacock/Goldstein with the motivation providing effective and cost-efficient way to access, view, modify, and update patient information, to improve the quality of patient healthcare. (see at least Edelson Column:1 Lines:31-38)

As per claim 13, Jeacock/Goldstein/Edelson as shown, disclose the limitations of claims 12. Goldstein further discloses the following limitations:

- *presenting a correlation among the preprocedure information, the patient condition information, and the time of the preprocedure, which are stored. (see at least Goldstein [0046])*

It would have been obvious to one of ordinary skill in the art at the time of the invention to add the feature of Goldstein into Jeacock/Goldstein/Edelson. One of ordinary skill in the art would have added these features into Jeacock/Goldstein/Edelson with the motivation to provide an improved method and system for recording, transmitting and maintaining patient information relevant to medical procedures to be performed on a patient, for higher quality health care. (see at least Goldstein [0024])

As per claim 18, Jeacock teaches:

- *a preprocedure information inputting unit for inputting preprocedure information comprising at least one of a type of a drug used for a preprocedure performed for a patient when performing an endoscopic examination, an amount of the drug, an appliance used for the preprocedure, and a name of a person who performs the preprocedure (see at least Jeacock Column:2 Lines:49-67 Column:3 Lines:1-10 Column:4 Lines:52-67 & Column:5 Lines:1-12)*
- *which is reservation information of the endoscopic examination; (see at least Jeacock Fig:5 & related text)*

- *a first abnormality information indicating presence/absence of an abnormality of a patient; (see at least Jeacock Column:3 Lines26-28 “(d) Questions on particular problems, such as allergies, and whether existing medications should be discontinued.”)*
- *a second abnormality information indicating the presence/absence of an abnormality of a patient; (see at least Jeacock Column:3 Lines26-28)*
- *after the preprocedure; (see at least Jeacock Claim:3)*

Jeacock does not disclose the following limitations, however Goldstein, as shown does:

- *a condition inputting unit for displaying the preprocedure information and inputting patient condition information, including information indicating a condition of the patient after the preprocedure; (see at least Goldstein [0057] “As information is obtained from patient prospects and patients, and from the medical practitioner's office, it may be entered into and retrieved from the system through various forms of input/output devices operatively connected to the main processing unit 10 and each of the remote CPUs 16, such as typing on keyboards, speech to text transcription methods, use of digitizers and scanners and other known methods. Information is displayed in various formats and can be viewed on the display devices 12 and 17 or printed using printers 13 and 18.”)*

- *a storing unit correlating and storing the preprocedure information, the patient condition information, and a time of the preprocedure. (see at least Goldstein [0054] “in a preferred embodiment includes, at the system representation end, a main processing unit 10 with data storage capability,”)*

It would have been obvious to one of ordinary skill in the art at the time of the invention to add the features of Goldstein into Jeacock. One of ordinary skill in the art would have added these features into Jeacock with the motivation to provide an improved method and system for recording, transmitting and maintaining patient information relevant to medical procedures to be performed on a patient, for higher quality health care. (see at least Goldstein [0024])

Jeacock/Goldstein does not disclose the following limitations, however Edelson, as shown does:

- *an examination reservation displaying unit displaying a list of examination reservation information; and (see at least Edelson Fig:2-5, & related text)*
- *a display controlling unit controlling a display form of the examination reservation information displayed on the examination reservation displaying unit, based on the patient condition information. wherein (see at least Edelson Fig:2-5, & related text)*
- *the display controlling unit displays one or more of the examination reservation information from among the examination reservation information displayed in the list, said one or more examination reservation information*

corresponding to the patient condition information having the first or the second abnormality information indicating the abnormality is occurring in the condition of the patient. (see at least Edelson Fig:2-5, 10, 13 & related text)

It would have been obvious to one of ordinary skill in the art at the time of the invention to add the features of Edelson to Jeacock/Goldstein. One of ordinary skill in the art would have added these features into Jeacock/Goldstein with the motivation providing effective and cost-efficient way to access, view, modify, and update patient information, to improve the quality of patient healthcare. (see at least Edelson Column:1 Lines:31-38)

11. Claims 19-22 are rejected under 35 U.S.C. 103(a) as being unpatentable over Goldstein (in view of Jeacock, in view of Edelson, in further view of Dulong et al. (US 6541902 B2) (hereinafter Dulong).

As per claim 19, Claim 19 contains substantially similar limitations to claim 1 and is therefore rejected for the same reasons given in regards to claim 1. Jeacock/Goldstein/Edelson as shown, disclose the limitations of claims 1. Claim 19 recites the additional limitation of:

a. *in reverse video* (Design Choice)

In reverse video is a design that is a mere matter of choice in ornamentality and produces no new mechanical effect or advantage does not constitute invention and "Counsel for appellant also present arguments relating to the proportioning and

tightness of fit of appellant's devices. Those matters are considered to involve mechanical skill only and to produce no such new or unexpected result as would justify the allowance of the appealed claims." See, *In re Seid*, 161 F.2d 229, 231, 73 USPQ 431, 433 (CCPA 1947)

Claim 19 also recites the limitation of:

b. *displayed in a popup window when a cursor is positioned on the examination reservation information displayed in reverse video* (see at least Dulong Column:14 Lines:30-33 "a pop-up window containing the entire medication description may be displayed when the display cursor is placed over any listed medication/order")

It would have been obvious to one of ordinary skill in the art at the time of the invention to add the features of Dulong to Jeacock/Goldstein/Edelson. One of ordinary skill in the art would have added these features into Jeacock/Goldstein/Edelson with the motivation providing effective and accurate way to display medical information, to improve the quality of patient healthcare. (see at least Dulong Column:2 Lines:45-50)

As per claim 20, Claim 20 contains substantially similar limitations to claim 9 and is therefore rejected for the same reasons given in regards to claim 9. Jeacock/Goldstein/Edelson as shown, disclose the limitations of claims 9. Claim 20 recites the additional limitation of:

c. *in reverse video* (Design Choice)

In reverse video is a design that is a mere matter of choice in ornamentality and produces no new mechanical effect or advantage does not constitute invention and "Counsel for appellant also present arguments relating to the proportioning and tightness of fit of appellant's devices. Those matters are considered to involve mechanical skill only and to produce no such new or unexpected result as would justify the allowance of the appealed claims." See, *In re Seid*, 161 F.2d 229, 231, 73 USPQ 431, 433 (CCPA 1947)

Claim 20 also recites the limitation of:

d. *displayed in a popup window when a cursor is positioned on the examination reservation information displayed in reverse video* (see at least Dulong Column:14 Lines:30-33 "a pop-up window containing the entire medication description may be displayed when the display cursor is placed over any listed medication/order")

It would have been obvious to one of ordinary skill in the art at the time of the invention to add the features of Dulong to Jeacock/Goldstein/Edelson. One of ordinary skill in the art would have added these features into Jeacock/Goldstein/Edelson with the motivation providing effective and accurate way to display medical information, to improve the quality of patient healthcare. (see at least Dulong Column:2 Lines:45-50)

As per claim 21, Claim 21 contains substantially similar limitations to claim 12 and is therefore rejected for the same reasons given in regards to claim 12.

Jeacock/Goldstein/Edelson as shown, disclose the limitations of claims 12. Claim 21 recites the additional limitation of:

e. *in reverse video* (Design Choice)

In reverse video is a design that is a mere matter of choice in ornamentality and produces no new mechanical effect or advantage does not constitute invention and "Counsel for appellant also present arguments relating to the proportioning and tightness of fit of appellant's devices. Those matters are considered to involve mechanical skill only and to produce no such new or unexpected result as would justify the allowance of the appealed claims." See, *In re Seid*, 161 F.2d 229, 231, 73 USPQ 431, 433 (CCPA 1947)

Claim 21 also recites the limitation of:

f. *displayed in a popup window when a cursor is positioned on the examination reservation information displayed in reverse video* (see at least Dulong Column:14 Lines:30-33 "a pop-up window containing the entire medication description may be displayed when the display cursor is placed over any listed medication/order")

It would have been obvious to one of ordinary skill in the art at the time of the invention to add the features of Dulong to Jeacock/Goldstein/Edelson. One of ordinary skill in the art would have added these features into Jeacock/Goldstein/Edelson with the motivation providing effective and accurate way

to display medical information, to improve the quality of patient healthcare. (see at least Dulong Column:2 Lines:45-50)

As per claim 22, Claim 22 contains substantially similar limitations to claim 18 and is therefore rejected for the same reasons given in regards to claim 18. Jeacock/Goldstein/Edelson as shown, disclose the limitations of claims 18. Claim 22 recites the additional limitation of:

g. *in reverse video* (Design Choice)

In reverse video is a design that is a mere matter of choice in ornamentality and produces no new mechanical effect or advantage does not constitute invention and "Counsel for appellant also present arguments relating to the proportioning and tightness of fit of appellant's devices. Those matters are considered to involve mechanical skill only and to produce no such new or unexpected result as would justify the allowance of the appealed claims." See, *In re Seid*, 161 F.2d 229, 231, 73 USPQ 431, 433 (CCPA 1947)

Claim 22 also recites the limitation of:

h. *displayed in a popup window when a cursor is positioned on the examination reservation information displayed in reverse video* (see at least Dulong Column:14 Lines:30-33 "a pop-up window containing the entire medication description may be displayed when the display cursor is placed over any listed medication/order")

It would have been obvious to one of ordinary skill in the art at the time of the invention to add the features of Dulong to Jeacock/Goldstein/Edelson. One of ordinary skill in the art would have added these features into Jeacock/Goldstein/Edelson with the motivation providing effective and accurate way to display medical information, to improve the quality of patient healthcare. (see at least Dulong Column:2 Lines:45-50)

Response to Arguments

12. Applicant's arguments received on 17 April 2008 have been fully considered but they are not persuasive. Applicants' arguments will be addressed herein below in the order in which they appear in the response filed 17 April 2008.

13. In response to Applicant's argument, it is respectfully submitted that the Examiner has applied new prior art to amended claim, 1, 9, 12, & 18, as well as added claims 19-22. The Examiner notes that the amended and added claims were not in the previously pending claims as such, Applicant's remarks with regard to the applications of the prior art used in the first Non-Final Office Actions to the amended and added claims are moot in light of the addition of the newly cited prior art references as disclosed above.

Conclusion

The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

Any inquiry of a general nature or relating to the status of this application or concerning this communication or earlier communications from the Examiner should be directed to **Rajiv J. Raj** whose telephone number is **(571) 270-3930**. The Examiner can normally be reached on Monday-Friday, 7:30am-5:00pm.

If attempts to reach the examiner by telephone are unsuccessful, the Examiner's supervisor, **Jerry O'Connor** can be reached at **571.272.6787**.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://portal.uspto.gov/external/portal/pair> <<http://pair-direct.uspto.gov>>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at **866.217.9197** (toll-free).

Any response to this action should be mailed to:

Commissioner of Patents and Trademarks
Washington, D.C. 20231

or faxed to **(571) 273-8300**.

Hand delivered responses should be brought to the **United States Patent and Trademark Office Customer Service Window:**

Randolph Building
401 Dulany Street
Alexandria, VA 22314.

Rajiv Raj /RJR/
Patent Examiner, Art Unit 3686
November 10, 2008

/Gerald J. O'Connor/
Supervisory Patent Examiner
Group Art Unit 3686